Remarks:

Claims 1-14 are pending in the present application. By this Amendment, claims 1, 8 and 10 are amended. Claims 1 and 8 are amended to correct a grammatical error, and claim 10 is amended to comply with U.S. patent practice by removing the "use" language from the claim.

No new matter is added to the application by this Amendment.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments and reconsideration of the application are thus respectfully requested. It is the applicant's position that all of the claims presented in this paper are allowable.

Allowable Subject Matter:

Applicant notes with appreciation that claims 2 and 9-14 have been identified as containing allowable subject matter.

Regarding the rejection of claim 1, 3, 4 and 6-8 under 35 USC 103(a) as being unpatentable over US 5387718 to Köhler et al. (hereinafter simply "Köhler"):

Applicants respectfully traverse the rejections of the foregoing claims in view of Köhler.

Prior to discussing the merits of the Examiner's position, the undersigned reminds the Examiner that the determination of obviousness under § 103(a) requires consideration of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 [148 USPQ 459] (1966): (1) the scope and content of the prior art; (2) the differences between the claims

and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. *McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1368, 67 USPQ2d 1649, 1653 (Fed. Cir. 2003). There must be some suggestion, teaching, or motivation arising from what the prior art would have taught a person of ordinary skill in the field of the invention to make the proposed changes to the reference. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). But see also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2D 1385 (U.S. 2007).

A methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

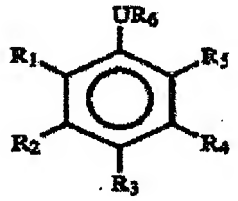
It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

The Patent Office alleges that Köhler teaches compounds wherein R_3 = alkyl having a fused C_{0-7} cycloalkyl ring R_1=R_2=R_4=R_5=H. Based on this allegation, Applicants assume that the Examiner is referring to the second definition of R_1-R_5 (see col. 1, lines 35-38

of Köhler) which teaches:

> **R_1-R_5 may be bridged by suitable bifunctional substituents, such as, e.g., —$(CH_2)_x$—, or —$(CH_2)_x$—Z—$(CH_2)_y$— (where Z represents a hetero atom; x=0-7, and y=0-7), or preferably unsaturated substituents such as are characteristic of anellated ring systems, e.g. (but not limited to) naphthyl, phenanthryl, anthracenyl, quinolyl, isoquinolyl, or indolyl.**

Applicants respectfully disagree with the Examiner's interpretation of the Köhler because Köhler teaches alkylphenyl alkyl thioethers having the general formula:



wherein

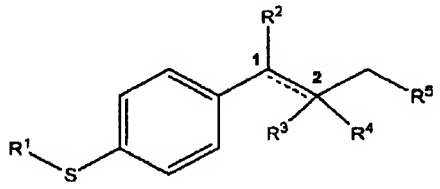
R_1-R_5 may each independently represent a C1-6 alkyl group or an aryl group or a functional group (see column 1, lines 29-34 of Köhler); further

R_1-R_5 may be **bridged** by suitable **bifunctional substituents**, such as, e.g., $-(CH_2)_x-$, or $-(CH_2)_x-Z-(CH_2)_y-$ (where Z represents a hetero atom; x=0-7, and y=0-7) (see col. 1, lines 35-38 of Köhler).

Köhler further teaches that "**adjacent pairs** of R_1, R_2, R_3, R_4, and R_5 **may together form** a fused ring group" (see col. 3, lines 6-11 of Köhler).

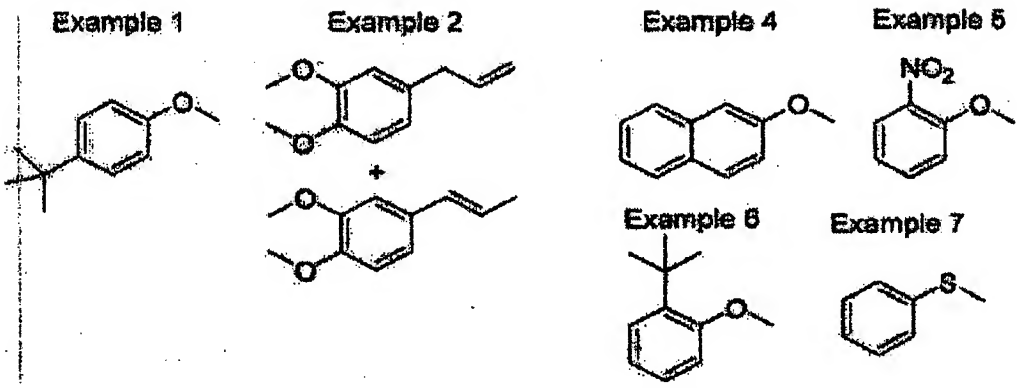
However, Köhler clearly does not teach or suggest compounds wherein R_3 alone is alkyl having a fused C_{0-7} cycloalkyl ring. Applicants submit that Köhler fails to teach or suggest any cycloalkyl whatsoever. Moreover, Applicants submit that the Examiner is misinterpretating Köhler and combining features of Köhler which are clearly not combinable to allegedly achieve the presently claimed flavour or fragrance compound.

Therefore Köhler does not teach or suggest a flavour or fragrance compound according to formula I (claim 1) and a compound of formula I (claim 8)



wherein the bond between C_1 and C_2 is a single bond; R^1 is methyl, ethyl, *i*-propyl, *n*-propyl; R^2 and R^3 are independently hydrogen or methyl; or R^2 and R^3 taken together is a divalent radical $(CH_2)_n$, $C(CH_3)_2$, or $CH(CH_3)$ which forms a cycloalkane ring together with the carbon atoms to which it is attached; R^4 and R^5 are independently hydrogen or methyl; or R^4 and R^5 taken together is a divalent radical $(CH_2)_n$, $(CH_2)_{n-1}CH(CH_3)_2$, or $(CH_2)_{n-1}CH(CH_3)$ which forms a cycloalkane ring together with the carbon atoms to which it is attached; n is an integer of 1, 2, 3, or 4; and wherein at least one cycloalkane ring is present as required by independent claims 1 and 8, respectively.

Additionally, as previously discussed in applicant's prior Amendment (filed in Sept. 2008) all the examples given in Köhler (viz., Examples 1, 2 and 4-7) are compounds far away from the class of compounds recited in claims 1 and 8. The compound of Example 1 is p-tert-butylphenyl methyl ether; the compounds of Example 2 are eugenol methyl ether and isoeugenol methyl ether; the compound of Example 4 is β-naphthyl methyl ether; the compound of Example 5 is 2-Nitroanisole; the compound of Example 6 is o-tert-butylphenyl ethyl ether; and the compound of Example 7 is thioanisole. The structures of the compounds of these examples are as follows:



It is clear that the compounds of the Examples 1, 2 and 4-7 of Köhler and the compounds taught in accordance with Köhler are *not* structurally the same as or similar to the class of compounds of the present claims and thus in the applicant's view, do not teach or even remotely suggest the class of compounds required by the present claims.

Contrary to the allegations by the Patent Office on page 3 of the Office Action, Köhler does not teach or suggest all the reagents recited in the present claims. Additionally, Applicant submits that if such teachings of all the reagents of the present invention is present in Köhler, such teachings or disclosure of all the reagents should be point out by the Examiner in the Office Action. Applicant further submits that such a disclosure regarding the claimed reagents does not exist in Köhler because the Patent Office fails to identify where such disclosure(s) is located within Köhler. Instead, the Patent Office alleges that if it is Applicant's position that this is not the case, it is the Patent Office position that the application contains inadequate disclosure. Applicant respectfully traverses these allegations.

By carefully defining the claimed class of compounds of formula (I) as recited in claims 1 and 8 in combination with Examples 1-6 of the present application, Applicant has sufficiently illustrated, to one of ordinary skill in the art, how to obtain the claimed properties and effects, namely by using a compound of formula (I) as defined in claims 1 and 8.

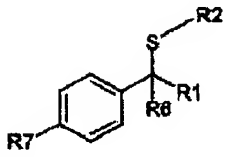
In view of the foregoing remarks, Applicant disagrees with the Patent Office's position, traverses the Patent Office's rejection and asserts that the Patent Office has not met the proper burden of proof to present and maintain the rejection; such are simply unsupported by the facts for the reasons noted above. Rather, Applicant contends that the Patent Office's grounds of rejection is at, at best, a hindsight reconstruction, using Applicants' claims as a template to reconstruct the invention by picking and choosing amongst isolated disclosures from the present application and Köhler. This is impermissible under the law. Accordingly, reconsideration of the propriety of the rejection of claims 1, 3, 4, 6 and 7 and its withdrawal is respectfully requested.

Regarding the rejection of claim 5 under 35 USC 103(a) as being unpatentable over Köhler in view of EP 1264547 to Grab et al. (hereinafter "Grab"):
Applicant respectfully traverses the rejection of the foregoing claim in view of Köhler and Grab.

The Patent Office acknowledges that Köhler fails to teach a household product containing alkylphenyl alkyl thioethers (see page 5 of the Office Action). The Patent Office introduces Grab as allegedly teaching the deficiencies of Köhler. The Patent Office alleges that it would have been obvious to have combined Grab and Köhler and that Grab discloses motivation to combine Grab with Köhler to achieve the present invention as alleged by the Patent Office.

Grab does not remedy the deficiencies of Köhler as described above with respect to independent claim 1, from which claim 5 indirectly depends. Specifically, Grab fails to teach or suggest that the specific features of formula (I) wherein at least one cycloalkane ring is present as required by claims 1. Instead, Grab, at best, teaches or suggests:

[0006] Accordingly, the invention provides in one of its aspects a flavour or fragrance composition comprising a compound of formula (I)



wherein R1 represents an alkyl group having from 1 to 4 carbon atoms which may be branched or unbranched; R2 represents, hydrogen; acyl, in particular selected from the group -(R3)C=O wherein R3 represents a branched or unbranched alkyl group having from 1 to 4 carbon atoms ; or an alkoxyalkyl group, in particular selected from the group -CH(R4)-OR5, wherein R4 represents hydrogen or a branched or unbranched alkyl group having from 1 to 4 carbon atoms; R5 represents a branched or unbranched alkyl group having from 1 to 4 carbon atoms; R6 represents hydrogen or methyl; and R7 represents hydrogen, methyl or alkoxy having 1 to 4 carbon atoms, e.g. methoxy.
[0007] R1, R3, R4 and R5 independently are particularly represented by methyl, ethyl, n-, or iso-propyl, and n-, or iso-butyl. R2 is particularly represented by hydrogen, formyl, acetyl, propionyl, butyryl, isobutyryl, 1'-ethoxyethyl, 1-methoxyethyl, or 2'(2'-methoxypropyl).

Because the features of independent claim 1, from which claim 5 indirectly depends, are not taught or suggested by Köhler and Grab, taken singly or in combination, these references would not have rendered the features of claim 5 obvious to one of ordinary skill in the art.

In view of the foregoing, reconsideration and withdrawal of this rejection are respectfully requested.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience. The early issuance of a *Notice of Allowability* is solicited.

CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;

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CERTIFICATION OF TELEFAX TRANSMISSION:

I hereby certify that this paper and any indicated enclosures thereto is being telefax transmitted to the US Patent and Trademark Office to telefax number: 571-273-8300 on the date shown below:

Allyson Ross — Date: 02 March 2009

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